

REMARKS

By this amendment, claims 17, 21 have been amended. Claims 10 and 29 have been canceled. Claims 1-9, 11-27, 30-45, and 56 are pending in the application. Applicants reserve the right to pursue the original claims and other claims in this and other applications.

Claims 10, 17-23, and 29 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 17 and 21 have been amended to change the phrase “at least approximately” to “substantially,” and claims 10 and 29 have been canceled. Applicant respectfully requests that the rejection of these claims be withdrawn.

Claims 1-9, 11-16, and 36-45 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Shizukuishi (US 6,734,031) in view of Tokumitsu (US 5,238,856). Claims 17-27, 30-35, and 56 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Hokari (US 5,493,143) in view of Tokumitsu. These rejections are respectfully traversed.

In order to establish a *prima facie* case of obviousness “the prior art reference (or references when combined) must teach or suggest all the claim limitations.” M.P.E.P. §2142.

Claims 1, 6, and 12 recite, *inter alia*, “at least one of said ... first micro-lenses at least abuts without overlapping at least one of said ... second micro-lenses.” (Emphasis added.) Claim 36 recites, *inter alia*, “said second micro-lenses contact without overlapping said first micro-lenses.” (Emphasis added.) Shizukuishi does not disclose such a limitation. Shizukuishi discloses “[t]he blue microlens patterns 12Ba

[sic] is formed to partially overlap with the green microlens 12G.” Col. 5, ln. 54-55; emphasis added. The lenses overlap, which is prohibited in claims 1, 6, 12, and 36.

Claim 17 recites, *inter alia*, “a micro-lens array ... substantially space-less between at least one of [a] plurality of first micro-lenses and at least one of [a] plurality of second micro-lenses.” Claim 24 recites, *inter alia*, “a micro-lens array, comprising: a first plurality of first micro-lenses ... and a second plurality of second micro-lenses ... wherein at least one of said plurality of first micro-lenses at least abuts without overlapping at least one of said plurality of second micro-lenses.” (Emphasis added.) Hokari does not disclose such a limitation. Hokari discloses the array of micro-lenses 9R, 9G, and 9B having an appreciable distance between them. Fig. 9. Hokari does not disclose the micro-lenses being substantially space-less or abutting and recited in claims 17 and 24.

Tokumitsu does not teach or suggest how to modify Shizukuishi or Hokari to obtain the claimed invention. In fact, Tokumitsu teaches “when the light receiving portions are reduced in size and therefore the color filters are also reduced in thickness, it is necessary to adjust the sensitivities of the color filters in a different way.” Col. 5, ln. 44-48. There is therefore no *prima facie* case of obviousness

Obviousness is based on factual findings. “Whether a patent claim is obvious under section 103 depends upon the answer to several factual questions and how the factual answers meld into the legal conclusion of obviousness *vel non*.” *McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1351 (Fed. Cir. 2001). The four underlying factual inquiries are: (1) the scope and content of the prior art; (2) the differences between the claims and the prior art; (3) the level of ordinary skill in the pertinent art; and (4) secondary considerations, if any, of non-obviousness. *Graham v. John Deere Co.*, 393 U.S. 1, 17-18 (1966).

There is no motivation to combine all of these references to obtain the invention of claim 1. Motivation or suggestion to combine or modify prior art references “must be clear and particular, and it must be supported by actual evidence.” *Teleflex, Inc. v. Ficos North America Corp.*, 299 F.3d 1313, 1334 (Fed. Cir. 2002). Because the “genius of invention is often a combination of known elements which in hindsight seems preordained,” the Federal Circuit requires a “rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references.” *McGinley*, 262, F.3d at 1351. Yet there is no teaching or suggestion within any of the references that provide a motivation to combine them.


The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680 (Fed. Cir. 1990). Thus, a showing of an obvious combination requires more than just an amalgam of references, each of which provides one feature of the claimed invention.

The Office Action has done no more than cite a group of references, each of which provides one feature of the claimed invention, and allege that their combination renders the invention obvious. However, without the benefit of hindsight, there would have been no motivation to combine these references and the Office Action has failed to provide proof of any such motivation. Applicants respectfully request that the 35 U.S.C. § 103(a) rejections of claims 1-9, 11-27, 30-45, and 56 be withdrawn.

In view of the above amendment, Applicants believe the pending application is in condition for allowance.

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Respectfully submitted

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